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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/580,553	05/26/2006	Daisuke Murakami	050388-0046	5981
20277	7590	01/31/2008	EXAMINER	
MCDERMOTT WILL & EMERY LLP			ADDISU, SARA	
600 13TH STREET, N.W.				
WASHINGTON, DC 20005-3096			ART UNIT	PAPER NUMBER
			3722	
MAIL DATE		DELIVERY MODE		
01/31/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)
	10/580,553	MURAKAMI ET AL.
	Examiner Sara Addisu	Art Unit 3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 25 May 2006.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 13-25 is/are pending in the application.
 4a) Of the above claim(s) 17-25 is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 13-16 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 26 May 2006 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>5/26/06</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: Page 14, paragraph 33, line 9, recites “pocket 5”. It should be “pocket 4”. Appropriate correction is required.

Claim Objections

2. Claims 17-25 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim can not depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.
3. Claim 1 is objected to because of the following informalities: line 3 recites “come of”. Examiner thinks it should be “come off”. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

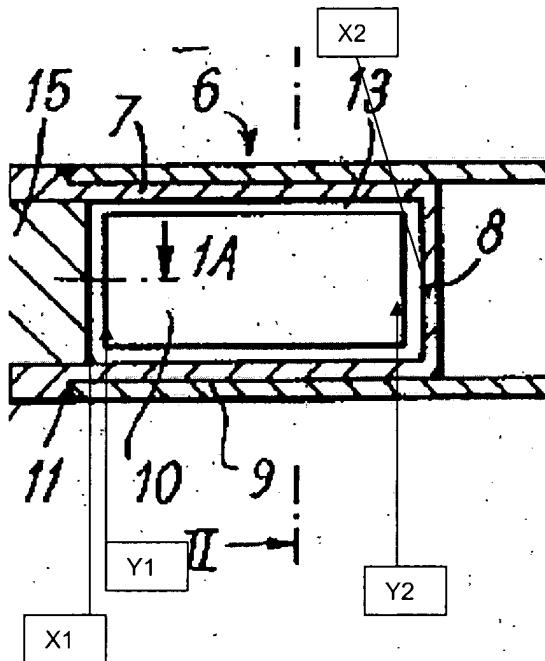
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 13-15 are rejected under 35 U.S.C. 102(b) as being anticipated by New (USP 4,061,438).

Regarding claims 13 and 14, New teaches a vibration suppressing cutting tool comprising a holder having a shank (1) formed with a pocket (7: sleeve is considered to be part of the shaft) in which a vibration suppressing piece (10) which is not coupled to said holder is received so as not to be able to come off said pocket ('438, figure 1). New also teaches pocket (7) having inner walls : end walls (8: flat surface) and side wall (9: cylindrical surface) wherein at least portions of the inner wall (i.e. end wall, 8) of said pocket that knock against said vibration suppressing piece (10) or portions of the surface of said vibration suppressing piece (i.e. the diameter portion/ the part facing wall 8, which is flat) that knock against said inner wall (8) of said pocket are flat surfaces ('438, col. 3, lines 15-18). Furthermore, New teaches clearance between the vibration suppressing piece (10) and wall surfaces (8,10), therefore said vibration suppressing piece (10) knocks against the wall surfaces wall when the holder vibrates during cutting ('438, col. 3, lines 24-33). Regarding claim 15, New teaches said pocket having first and second flat inner wall surfaces (X1, X2: see figure below) opposed to each other, and wherein said vibration suppressing piece (10) has third and fourth flat surfaces (Y1, Y2: see figure below) and is received in said pocket such that said third and fourth surfaces face said first and second surfaces, respectively, with a clearance defined between said first and second surfaces and said vibration suppressing piece, said first, second, third

and fourth surfaces being oriented so as to cross the direction
in which said holder vibrates during cutting.



Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over New (USP 4,061,438).

New teaches a vibration suppressing cutting tool comprising a holder having a shank (1) formed with a pocket (7: having inner walls: end walls (8) and side wall (9)) in which a vibration suppressing piece (10) which is not coupled to said holder is received, as set forth in the above rejection. New discloses all of the claimed limitations (i.e. pocket and vibration suppressing piece having flat surfaces that are perpendicular to the central axis of the shank wherein the opposed inner wall surfaces X1, X2 of said pocket having a greater area than other surfaces Y1, Y2, of said vibration suppressing piece: see figure above) except for the sections being rectangular). It would have been an obvious matter of design choice to make the different portions of the vibration suppressing piece of whatever form or shape was desired or expedient to fit the bore/pocket it is received in. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara Addisu at (571) 272-6082. The examiner can normally be reached on 8:30 am - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica Carter can be reached on (571) 272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sara Addisu
(571) 272-6082

1/24/08

Monica S. Carter
MONICA CARTER
SUPERVISORY PATENT EXAMINER